



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,478	01/11/2001	Dale C. Gledhill	03411.006	9341

22913 7590 06/16/2005

WORKMAN NYDEGGER
(F/K/A WORKMAN NYDEGGER & SEELEY)
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER

CHIANG, JACK

ART UNIT PAPER NUMBER

2642

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,478

Applicant(s)

GLEDHILL, DALE C.

Examiner

Jack Chiang

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 20, 21 and 23-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 20-21, 23-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

NOTE: claims 7-13 and 22, drawn to a non-elected claims without traverse, are hereby cancelled by the examiner (see page 10 of the remarks filed on 01/12/05).

Claims 14-19 had been previously cancelled.

Claims 1-6, 20-21, 23-37 are pending.

CLAIMS

Art Rejection

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, 21, 23, 25-33, 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Castle et al. (US 6347163).

Regarding claim 1, Castle shows a shoulder rest comprising:

A first portion (400, 208, 204 in fig. 13d) for abutting against a user's shoulder;

Base portions (196, 198; or 26, 28) extending from the first portion (400, 208, 204) to terminal ends, the terminal ends (29 on 28, a similar location for 26, 196, 198) of the base portions (196, 198; or 26, 28) configured for abutting against different longitudinal

Art Unit: 2642

portions of a back side of a handset (see fig. 13d, 12, 12a, note 196, 198

wrapping/abutting around the back and ends of the handset);

A cut-out portion (between 196-198; between 26, 28) between the base portions;

At least a portion of the base portions (196 or 198; 26, 28) are configured to be selectively positioned closer together or farther away from each other so that the shoulder rest can conform to differently shaped handsets (see fig. 13d, 12, 12a).

Regarding claim 23, Castle shows a shoulder rest comprising:

A top portion (400, 208, 204 in fig. 13d) for abutting against a user's shoulder;

A bottom portions (196, 198; or 26, 28) extending from the top portion (400, 208, 204),

the bottom portion comprising first and second base portions (196, 198; or 26, 28)

extending from the top portion, at least a portion of the base portions (196 or 198; 26, 28) are configured to be selectively positioned closer together or farther away from each other;

A flexible strap (i.e. 22) extending between terminal ends (i.e. 29 on 28, and a similar location on 26) of the base portions (i.e. 26, 28).

Regarding claim 29, Castle shows a shoulder rest comprising:

A first portion comprising means (400, 208, 204 in fig. 13d) for abutting against a user's shoulder;

A second portion comprising a first base portion and a second base portions (196, 198; or 26, 28), and a space (between 196, 198; or 26, 28), the second portion comprising

means (196, 198; or 26, 28) for increasing or decreasing the size of the space so that the shoulder rest can conform to differently shaped handsets;

Means (loop formed by 196, 198; or 26, 28) for connecting the second portion to a handset so that the terminal ends (29 on 28, a similar location for 26) of the first and second base portions (196, 198; or 26, 28) are configured to abut against different longitudinal portions of a back side of a telephone handset (see fig. 13d, 12, 12a).

Regarding claims 2-6, 21, 25-28, 30-33, 35-36, Castle shows:

The curved first portion (see 400);

The first and base portions (400; 196, 198 or 26, 28) of the shoulder rest are part of a hollow body (between 196-198; or 26, 28) of the shoulder rest, and are flexible;

A strap (i.e. 22) between the base portions (i.e. 26, 28), Castle further shows the first portion (see 400) narrows along a length from a front end to a narrowest portion and then widens again

The first and second base portions or means (196, 198; or 26, 28) for increasing or decreasing the size of the space between the first and second base portions (196, 198; or 26, 28).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20, 24, 34, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castel et al. in view of Russo.

Regarding claim 20, 24, 34, 37, Castel shows the mounting of the shoulder rest onto the handset.

Castel differs from the claimed invention in that it does not show an adhesive for such mounting.

However, Russo teaches providing an adhesive (i.e. see 28) for mounting a shoulder rest onto a handset.

Hence, the concept of mounting the shoulder rest onto the handset is well taught by both Castel and Russo, it would have been obvious for one of ordinary skill in the art to modify Castel's mounting with an adhesive as taught by Russo, such that to re-enforce the mounting of the shoulder rest as taught by Russo's use of adhesive.

5. Claims 29-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Walter (US 3567871).

Regarding claim 29, Walter shows a shoulder rest comprising:

A first portion comprising means (14) for abutting against a user's shoulder;

A second portion comprising a first base portion and a second base portions (two ends of 18 where 22-23 are supported), and a space (concave 18 between two ends), the second portion (two ends of 18) comprising means (rubber in col. 2, line 50) for increasing or decreasing the size of the space so that the shoulder rest can conform to

differently shaped handsets (note: characteristic of a rubber allows the shoulder rest to be increased/decreased in size of the space between two ends);

Means (22-23) for connecting the second portion to a handset so that the terminal ends (ends surfaces of 18) of the first and second base portions (two ends of 18) are configured to abut against different longitudinal portions of a back side of a telephone handset (note: characteristic of a rubber allows the shoulder rest to be increased/decreased in size of the space between two ends).

Regarding claims 30-34, Walter shows:

The curved surface (see 14);

Means for increasing/decreasing in size of the space comprising a flexible material (rubber in Walter); and

An adhesive (22-23).

ARGUMENT

6. In response to the remarks (pages 9-21) filed on 01/12/05, the 112 first paragraph rejection and the Russo rejection are now withdrawn. Therefore, no further discussion is made regarding the above two rejections.

On pages 17-18, applicant argues that Castle does not teach "said terminal ends of said base portions configured for abutting against different longitudinal portions of a back of said telephone handset.

The examiner disagrees. Castle does teach that "the terminal ends of the base portions (196, 198; or 26, 28) configured for abutting against different longitudinal

portions of a back side of a handset (see fig. 13d, 12, 12a, note 196, 198 wrapping/abutting around the back and ends of the handset).

Applicant also argues that Castle lacks "a flexible strip extending between the terminal ends of the first and second base portions".

The examiner disagrees. Castle does teach that "a flexible strap (i.e. 22) extending between terminal ends (i.e. 29 on 28, and a similar location on 26) of the base portions (i.e. 26, 28)".

On page 19, about claim 29, applicant has substantially the same argument, see comments above.

On pages 19-20, Russo is cited to use an adhesive, the Russo rejection by itself has been withdrawn. Therefore, argument, such as last paragraph of page 20, is moot.

7. Applicant's arguments with respect to claims 1-6, 20-21, 23-37 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's submission of the requirements for the joint research agreement prior art exclusion under 35 U.S.C. 103(c) on 01/12/05 prompted the new ground(s) of rejection under 37 CFR 1.109(b) presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.02(I)(3). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

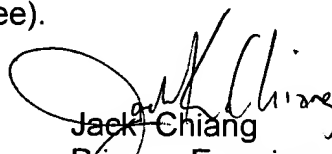
Art Unit: 2642

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 571-272-7483. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jack Chiang
Primary Examiner
Art Unit 2642